



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,329	09/18/2000	Ronni S. Sterns	CRT/11842	3765

7609 7590 09/23/2002

RANKIN, HILL, PORTER & CLARK, LLP
700 HUNTINGTON BUILDING
925 EUCLID AVENUE, SUITE 700
CLEVELAND, OH 44115-1405

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
----------	--------------

3712

DATE MAILED: 09/23/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

22

Office Action Summary	Application No.	Applicant(s)	
	09/663,329	STERNS ET AL.	
	Examiner	Art Unit	
	Kurt Fernstrom	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 10, 13-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10, 13-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3712

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Renegar, and further in view of Tucker. Campo Agud discloses in Figures 1 and 2 and in the specification a display comprising a board 1 that can be seen by a plurality of people and a plurality of display cards 7 that are detachably secured to the board, wherein each card comprises a source phrase in a first language and a target phrase in a second language which is a translation of the source phrase. Campo Agud fails to disclose that each card further comprises a phonetic transliteration of the target phrase. Phonetic transliterations are commonly provided in foreign language teaching devices. Renegar discloses in Figures 2 and 3 and in column 6, line 60 to column 7, line 15 of the specification a display card for teaching a foreign language comprising source phrases in a first language, target phrases in a second language which are translations of the corresponding source phrases and a phonetic transliteration of each target phrase. Renegar further discloses that the source phrase and target phrase are next to each other, while the phonetic transliteration is located beneath both phrases. It would have been obvious to one of

Art Unit: 3712

ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing a phonetic transliteration of the target phrase on each card for the purpose of showing the user how to correctly pronounce the phrase in the target language. Campo Agud further fails to disclose that each card has a background color corresponding to a subject or category. Color coded display cards are well known. Tucker discloses in column 4, lines 24-65 a display device comprising a plurality of display cards, whereby each card has a color corresponding to the category of speech (noun, verb, etc.) the word printed on the card belongs to. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Renegar by providing an appropriate background color to each display card for the purpose of allowing the user to easily categorize the cards.

3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Renegar and Tucker, and further in view of Hopp. Campo Agud as viewed in combination with Renegar and Tucker discloses all of the limitations of claims 2-4 with the exception of the means for attaching a plurality of boards to each other. Modular display boards are well known. Hopp discloses in Figures 3, 5 and 8 and in column 3, lines 25-47 a display device comprising a plurality of boards 39, each board having along its top wall a first connector 43 which is substantially mushroom shaped, and along its bottom all a second connector 42 comprising a substantially mushroom shaped slot which cooperates with the connector 43 of another board to join a plurality of boards together. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in

Art Unit: 3712

combination with Renegar and Tucker by providing a protrusion and a slot along the top and bottom walls of each board for the purpose of allowing the user to attach a plurality of boards to each other. While claim 4 recites a slot along the top wall and a protrusion along the bottom wall, rather than vice versa, this arrangement would have been obvious as an aesthetic choice of design and because the claimed arrangement does not yield any particular benefits not realized by the Hopp disclosure.

4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Renegar and Tucker, and further in view of Rellinger. Campo Agud as viewed in combination with Renegar and Tucker discloses all of the limitations of claims 7 and 8 with the exception of the fasteners comprising magnets. Magnetic display boards are well known. Rellinger discloses in column 3, lines 9-32 a display device comprising a magnetic board 10 and a plurality of magnetic display cards 15. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Renegar and Tucker by providing a magnetic board and magnetic display cards for the purpose of allowing the user to securely and releasably attach the cards to the board.

5. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Owen, and further in view of Hopp. Campo Agud discloses in Figures 1 and 2 and in the specification a display comprising a board 1 that can be seen by a plurality of people and a plurality of display cards 7 that are detachably secured to the board, wherein each card comprises a source phrase in a first language and a target phrase in a second language which is a

Art Unit: 3712

translation of the source phrase. Campo Agud further discloses in Figure 1 that the board has top and bottom walls, and flanges attached to the top and bottom walls. The front wall, top wall, bottom wall and flanges define a chamber in which cards can be stored. Campo Agud fails to disclose that the flanges are located in the rear of the device. Owen discloses in Figure 2 and in the specification a display device comprising a display board having a front wall 12, top wall 16, bottom wall 22 and rear flanges 27 attached to the top and bottom walls. The front wall, top wall, bottom wall and flanges define a chamber in which cards can be stored. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing rear flanges to the board for the purpose of defining a storage area and for the purpose of providing means to attach the board to a support surface. Campo Agud also fails to disclose means for attaching a plurality of boards to each other. Modular display boards are well known. Hopp discloses in Figures 3, 5 and 8 and in column 3, lines 25-47 a display device comprising a plurality of boards 39, each board having along its top wall a first connector 43 which is substantially mushroom shaped, and along its bottom all a second connector 42 comprising a substantially mushroom shaped slot which cooperates with the connector 43 of another board to join a plurality of boards together. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Owen by providing a protrusion and a slot along the top and bottom walls of each board for the purpose of allowing the user to attach a plurality of boards to each other. While claim 13 recites a slot along the top wall and a protrusion along the bottom wall, rather

Art Unit: 3712

than vice versa, this arrangement would have been obvious as an aesthetic choice of design and because the claimed arrangement does not yield any particular benefits not realized by the Hopp disclosure.

6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Owen and Hopp, and further in view of Rellinger. Campo Agud as viewed in combination with Owen and Hopp discloses all of the limitations of claims 14 and 15 with the exception of the fasteners comprising magnets. Magnetic display boards are well known. Rellinger discloses in column 3, lines 9-32 a display device comprising a magnetic board 10 and a plurality of magnetic display cards 15. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Owen and Hopp by providing a magnetic board and magnetic display cards for the purpose of allowing the user to securely and releasably attach the cards to the board.

7. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Owen and Hopp, and further in view of Veazey. Campo Agud as viewed in combination with Owen and Hopp discloses all of the limitations of claim 16 with the exception of the end caps. Veazey discloses in Figure 6 and in column 5, lines 3-17 a display device comprising a display board having end caps 62 and 66. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Owen and Hopp by providing end caps for the purpose of improving the appearance of the device. Campo Agud as viewed in combination with Owen discloses all of the limitations of claim

Art Unit: 3712

18 with the exception of the bracket by which the device can be attached to a wall. Display boards with mounting brackets are well known. Veazey discloses in Figure 1 and in column 3, lines 11-60 a display device comprising a display board 10 having a flange 42 and a bracket 36 for hanging the flange, thus attaching the board to a wall. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud as viewed in combination with Owen by providing a bracket for the purpose of allowing the user to securely and releasably attach the board to a wall.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campo Agud in view of Renegar, and further in view of Owen, Hopp, Rellinger, Tucker and Veazey. Campo Agud discloses in Figures 1 and 2 and in the specification a display comprising a board 1 that can be seen by a plurality of people and a plurality of display cards 7 that are detachably secured to the board, wherein each card comprises a source phrase in a first language and a target phrase in a second language which is a translation of the source phrase. Campo Agud further discloses in Figure 1 that the board has top and bottom walls, and flanges attached to the top and bottom walls. The front wall, top wall, bottom wall and flanges define a chamber in which cards can be stored. Campo Agud fails to disclose that each card further comprises a phonetic transliteration of the target phrase. Phonetic transliterations are commonly provided in foreign language teaching devices. Renegar discloses in Figures 2 and 3 and in column 6, line 60 to column 7, line 15 of the specification a display card for teaching a foreign language comprising source phrases in a first language, target phrases in a second language which are translations of the

Art Unit: 3712

corresponding source phrases and a phonetic transliteration of each target phrase. Renegar further discloses that the source phrase and target phrase are next to each other, while the phonetic transliteration is located beneath both phrases. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing a phonetic transliteration of the target phrase on each card for the purpose of showing the user how to correctly pronounce the phrase in the target language. Campo Agud further fails to disclose rear flanges. Owen discloses in Figure 2 and in the specification a display device comprising a display board having a front wall 12, top wall 16, bottom wall 22 and rear flanges 27 attached to the top and bottom walls. The front wall, top wall, bottom wall and flanges define a chamber in which cards can be stored. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing rear flanges to the board for the purpose of defining a storage area and for the purpose of providing means to attach the board to a support surface. Owen also fails to disclose means for attaching a plurality of boards together. Modular display boards are well known. Hopp discloses in Figures 3, 5 and 8 and in column 3, lines 25-47 a display device comprising a plurality of boards 39, each board having along its top wall a first connector 43 which is substantially mushroom shaped, and along its bottom wall a second connector 42 comprising a substantially mushroom shaped slot which cooperates with the connector 43 of another board to join a plurality of boards together. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing a protrusion and a slot along the top and bottom walls of each board for the purpose of

Art Unit: 3712

allowing the user to attach a plurality of boards to each other. While claim 19 recites a slot along the top wall and a protrusion along the bottom wall, rather than vice versa, this arrangement would have been obvious as an aesthetic choice of design and because the claimed arrangement does not yield any particular benefits not realized by the Hopp disclosure. Campo Agud further fails to disclose a magnetic board and cards. Rellinger discloses in column 3, lines 9-32 a display device comprising a magnetic board 10 and a plurality of magnetic display cards 15. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing a magnetic board and magnetic display cards for the purpose of allowing the user to securely and releasably attach the cards to the board. Campo Agud also fails to disclose that each card has a color corresponding to a subject or category. Color coded display cards are well known. Tucker discloses in column 4, lines 24-65 a display device comprising a plurality of display cards, whereby each card has a color corresponding to the category of speech (noun, verb, etc.) the word printed on the card belongs to. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Campo Agud by providing an appropriate background color to each display card for the purpose of allowing the user to easily categorize the cards. Campo Agud fails to disclose a bracket on which the flange can be hung. Veazey discloses in Figure 1 and in column 3, lines 11-60 a display device comprising a display board 10 having a flange 42 and a bracket 36 for hanging the flange, thus attaching the board to a wall. It would have been obvious to one of ordinary skill in the relevant art to modify the device

Art Unit: 3712

disclosed by Campo Agud as viewed in combination with Owen by providing a bracket for the purpose of allowing the user to securely and releasably attach the board to a wall.

Allowable Subject Matter

9. Claim 20 is allowed.

Response to Arguments

10. Applicant's arguments filed on July 3, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The motivation to modify a reference does not need to come from the primary reference itself, and also does not need to be precisely the same motivation contemplated by applicant. In this case, the motivation to provide a phonetic transliteration is well known, and is disclosed by Renegar; namely, the transliteration allows the user to learn pronunciation. The language added to the claims pertaining to enabling the user to communicate "vocally" and "without learning the

Art Unit: 3712

vocabulary or grammar of the second language” is not deemed to have patentable weight because it is functional language which describes the intended purpose of the invention, without further limiting the structure of the apparatus itself.

In response to applicant's argument that Rellinger is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, although Rellinger is not directed to the field of foreign language teaching devices, it is pertinent to the problem of attaching display cards to a display board, and solves the problem in the same manner contemplated by applicant. The combination of Rellinger with the other references is proper.

In response to applicant's argument with respect to claim 10, the structure of Campo Agud comprises front, top, bottom walls and flanges wherein cards can be stored. Although the primary purpose of the flanges is to display cards, “can be stored” is a vague phrase which is read on by Campo Agud. Certainly, cards can be stored within the flanges when the device is not in use, or when only a portion of the device is in use. Also, the combination of Owen with Campo Agud is proper because the language is directed to the structural elements of the board which allow the board to store cards, and Owen is directed to that problem. Again, the motivation to modify Campo Agud by providing flanges in the back, that of providing means for both storage of cards and attachment of the board to a wall, is disclosed by Owen.

Art Unit: 3712

The combination of Veazey with Campo Agud is also proper for the same reason. The problem with which applicant was concerned was the structural features of a display board. The end caps and bracket of claims 16 and 18 do not appear to interact with the foreign language cards of the board such that the combinations yield any unexpected benefits; thus, combination of a generic display board reference with the foreign language teaching board of Campo Agud is proper.

In response to applicant's argument that the end caps of Veazey would not be obvious to combine with the boards of Campo Agud and Renegar, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument with respect to claim 19 that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Art Unit: 3712

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

September 11, 2002


Kien T. Nguyen
Primary Examiner